

Exhibit

I, PURITA T. EUGENIO, hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, in an envelope addressed to COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VA 22202-3514 on the date shown below.

Typed or Printed Name of Person Signing Certificate: PURITA T. EUGENIO

Signature: Purita T. Eugenio

Date: AUGUST 20, 2003

Express Mail Label: EK471096060US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

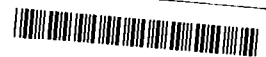
MARK D. TANNEN,

Opposer,

vs.

JAY MACK,

Applicant.



08-22-2003

U.S. Patent & TMO/c/TM Mail Rpt Dt. #58

Opposition No.: 91151109

Serial No.: 75/845,350

**APPLICANT'S OBJECTION TO OPPOSER'S MOTION TO EXTEND TIME TO
OBJECT AND/OR RESPOND TO DISCOVERY AND TO EXTEND TERMS FOR
DISCOVERY AND TESTIMONY; MOTION TO COMPEL RESPONSE TO
DISCOVERY WITHOUT OBJECTIONS**

Applicant objects to Opposer's motion to the Board requesting an order: (i) extending Opposer's time to object and/or respond to Applicant's first set of document requests and interrogatories, served by mail on July 7, 2003, by a period of eighteen days and (ii) extending the discovery, testimony and trial dates by a period of ninety (90) days. Applicant also respectfully moves the Board to compel Opposer to respond to Applicant's first set of document requests and interrogatories, without objections.

[illegible]

A. Facts Concerning Discovery Requests

The first attempt at any contact with counsel for the Applicant was not until Friday, August 8, 2003, just one business day before the time that Opposer's responses were due under 37 C.F.R. §2.119.¹ This first attempt at contact to request an extension from Applicant was by e-mail only. Both attorneys for Applicant were out of town and unavailable

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for contact on August 8, 2003, however, other employees of the Law Firm for the Applicant were available to respond to Opposer, had he called them. In addition, both attorneys had their e-mail account's "out of office assistant" turned on. The effect of this assistant being turned on resulted in an automatic computer generated reply being sent immediately to anyone that sent an e-mail to either of these attorney's e-mail accounts.² Upon Applicant's counsels return to the office on August 11, 2003, they each had numerous e-mails to review.

August 11, 2003 was the last day allowed to respond to Applicant's first set of document requests and interrogatories under 37 C.F.R. §2.119. On that last day for response, counsel for Opposer left a phone message for Applicant's counsel, the e-mail request for extension of time from counsel for Opposer was reviewed by Applicant's counsel, and Applicant's counsel sent an e-mail to Applicant asking for direction on Opposer's request.³

On August 13, 2003, Applicant contacted his counsel, and advised that he did not wish to consent to any extensions or further delay in the discovery process. A letter was sent to counsel for Opposer that same day, informing Opposer of the non consent to discovery extensions.⁴

On August 15, 2003, counsel for Applicant received Opposer's motion to extend time. Counsel for Applicant called counsel for Opposer on August 18, 2003 to discuss discovery. At that time, Applicant offered to stipulate to extend the time to respond to Applicant's first set of document requests and interrogatories by eighteen days, if Opposer

²See Good Declaration, No. 5, and Daunt Declaration, No. 2.

³See Good Declaration, No. 6, and Daunt Declaration, Nos. 3-4.

⁴See Good Declaration, No. 7.

would do so **without objections**. Counsel for Opposer advised that he could not consent to respond without objections, but would pass on this offer to Opposer. On August 19, 2003, counsel for Opposer further advised via e-mail that Opposer had not waived his right to object to Applicant's document requests and interrogatories.

B. Argument Against Granting Extension of Time

(1) Opposer Does Not Have Good Cause For Extension.

Opposer has not demonstrated with particularity any facts which support good cause for the requested extension. Opposer states in his motion that the basis for the extension "is that Opposer has been traveling and the discovery sought is extensive." "A motion to extend must set forth with particularity the facts said to constitute good cause for the requested extension; mere conclusory allegations lacking in factual detail are not sufficient." TBMP §509.01(a) "The standard for allowing an extension of a prescribed period prior to the expiration of that period is good cause." *Baron Philippe de Rothschild, S.A. v. Styl-Rite Optical Mfg. Co.* 55 U.S.P.Q.2D (BNA) 1848 (TTAB 2000), *See also* TBMP §509. In *Rothschild*, the applicant's motion to extend discovery was denied by the Board, when counsel knew of the unavailability of a witness a month before, yet delayed until the last day to seek an agreement on an extension of time. In the case at bar, the circumstances are the same. Counsel knew that Opposer was traveling, and counsel knew the extent of the discovery requests. Counsel for Opposer did not even attempt to contact counsel for the Applicant, until thirty-two days after he had been served with the discovery requests. Opposer has submitted no reason for his dilatory handling of these discovery requests, not meeting the standard for "good cause". It

is also undisputed that Opposer waited until the last business day before discovery responses were due to even attempt contacting counsel for Applicant to request an extension of time to answer, and filed this motion on the day discovery was actually due.

(2) Opposer's Request Is Based On Unreasonable Delay.

Based on the generalized, statement in Opposer's motion that "Opposer requires additional time to review the discovery sought by the Applicant and his files", it appears that the extension is being requested based on Opposer's lack of diligence in responding to the requested discovery. ". . . [A] party moving to extend time must demonstrate that the requested extension of time is not necessitated by the party's own lack of diligence or unreasonable delay in taking the required action during the time previously allotted therefor. The Board will 'scrutinize carefully' any motion to determine whether the requisite good cause has been shown." *Id.* In the case at bar, the Opposer has submitted no facts that support the good cause required for the requested extension, nor demonstrated that the request for extension was not caused by Opposer's own lack of diligence or unreasonable delay.

(3) Opposer's Motion Is Untimely.

Applicant received the Opposer's Motion to Extend Time to Object and/or Respond to Discovery and to Extend Terms for Discovery and Testimony on Friday, August 15, 2003. The certificate of service to Robert T. Daunt at Davis & Schroeder, was signed by Paul J. Reilly and dated August 11, 2003. The above-mentioned Motion and certificate of service were received in a "Baker Botts L.L.P." envelope, that bore a single New York, New

York postmark dated August 12, 2003.⁵ It is undisputed that Applicant's first set of document requests and interrogatories, served by first class mail on July 7, 2003. Pursuant to Trademark Rule 2.119(c), 37 C.F.R. 2.119(c), "[w]henver a party is required to take some action within the prescribed period after service of a paper upon the party by another party and the paper is served by first class mail, 'Express Mail,' or overnight courier, 5 days shall be added to the prescribed period." Under Rule 33 of the Fed. R. Civ. P. and Trademark Rule 2.120, 37 C.F.R. 2.120, responses to interrogatories and document requests must be served within 30 days from the date of service of such discovery requests. By adding the 5 days of Rule 2.119 to the 30, Opposer is entitled to 35 days within which to respond, making the due date for Opposer's objections and responses August 11, 2003. Because Opposer did not respond to the propounded discovery within the 35 days, and because this motion was not filed (based on the postmarked date) within 35 days, the time to respond **or object** may not be extended by Opposer's late filed motion.

Therefore, Opposer's motion for extension of time to object and/or respond to Applicant's first set of document requests and interrogatories, served by mail on July 7, 2003, should be denied.

2. Opposer's Motion To Extend Terms for Discovery and Testimony Should Be Denied.

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application for his mark, the likelihood that Opposer could propound any meaningful discovery upon the Applicant that would have a bearing on these proceedings is highly unlikely. When considering discovery matters, the Board has held that:

A party may not wait until the waning days of the discovery period to serve his discovery requests or notices of deposition and then be heard to complain that he needs an extension of the discovery period in order to take additional discovery. Mere delay in initiating discovery does not constitute good cause for an extension of the discovery period. If a party believes that issues in a case are complex and may involve lengthy discovery, it is his responsibility to begin taking discovery early in the discovery period. To allow an extension for all purposes herein would be to reward petitioner for its delay in initiating discovery, a result which is to be discouraged. *Luehrmann v. Kwik Kopy Corp.* 2 U.S.P.Q.2D 1303 (TTAB 1987)

As of the day these papers were filed, there remains less than two weeks until the close of discovery, yet there have been no discovery requests submitted by Opposer. There is simply no good cause for any extension of the discovery period in this case. As such, Applicant respectfully requests that Opposer's Motion to extend the terms for Discovery and Testimony be denied.

3. Opposer Should Be Compelled To Answer Applicant's Discovery Requests Without Objections.


Attached herewith and incorporated by reference as Exhibit 3, are Applicant's first set of document requests and interrogatories, served by first class mail on July 7, 2003. As stated above, Opposer has not responded to Applicant's discovery requests in any manner, and filed the instant motion, after the responses were due (as proved by postmark), on August 12, 2003. Because the Opposer did not object and/or respond to Applicant's discovery

requests, all objections to these requests have been waived. Fed. R. Civ. P. 33(b)(4) provides that untimely objections are “waived unless the party's failure to object is excused by the court for good cause shown.” The same standard applies to requests for production under Fed. R. Civ. P. 34. *See Pulsecard, Inc. v. Discover Card Servs., Inc.*, 168 F.R.D. 295, 303 (D. Kan. 1996). In this case, there has been no showing by the Opposer, with any reasonable particularity, for any good cause reason for extension. Courts have held that the good cause standard primarily considers the diligence of the party. The party seeking an extension must show that despite due diligence it could not have reasonably met the scheduled deadlines. “Carelessness is not compatible with a finding of diligence and offers no reason for a grant of relief. In addition, the lack of prejudice to the nonmovant does not show good cause.” *Deghand v. Wal-Mart Stores, Inc.*, 904 F. Supp. 1218, 1221 (D. Kan. 1995) (internal citations omitted).

Counsel for Applicant has made a good faith effort by telephone conference and e-mail to resolve with Opposer the issues presented in this motion, and has been unable to reach agreement. Applicant has advised Opposer that he would agree to an extension of the eighteen days requested by Opposer to respond to Applicant's discovery requests, so long as Opposer agreed to answer the discovery requests **without objections**. Opposer has not, as of the date of this pleading, agreed to Applicant's offer.

In addition, Opposer waited until the last minute to attempt to contact Applicant regarding Opposer's alleged difficulty or inability to timely respond to Applicant's discovery requests, and has demonstrated no good faith reason for delay of this process.

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Robert T. Daunt, Esq.
Mark W. Good, Esq.
DAVIS & SCHROEDER,
A PROFESSIONAL CORPORATION
215 West Franklin St., Fourth Floor
P. O. Box 3080
Monterey, CA 93942-3080
Telephone: (831) 649-1122
Facsimile: (831) 649-0566
E-mail: rtd@NetLawyers.com
mark@netlawyers.com

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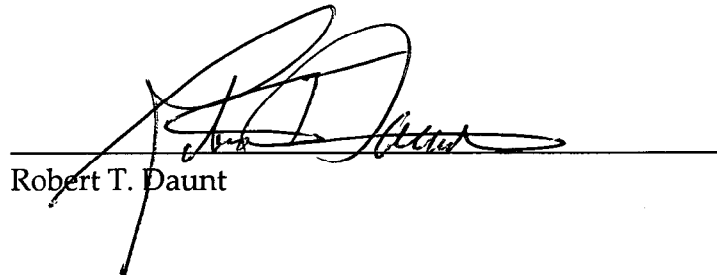
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing APPLICANT'S OBJECTION TO OPPOSER'S MOTION TO EXTEND TIME TO OBJECT AND/OR RESPOND TO DISCOVERY AND TO EXTEND TERMS FOR DISCOVERY AND TESTIMONY; MOTION TO COMPEL RESPONSE TO DISCOVERY WITHOUT OBJECTIONS was mailed FIRST CLASS mail, postage prepaid, this 20th day of August, 2003 on Opposer's counsel:

Paul J. Reilly, Esq.
BAKER BOTTS, L.L.P.
30 Rockefeller Plaza, 44th Floor
New York, NY 10112-0228



Robert T. Daunt

THAB

00/00/00 00:00:00

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Typed or Printed Name of Person Signing Certificate: PURITA T. EUGENIO

Signature: Purita T. Eugenio

Date: AUGUST 20, 2003

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD



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U.S. Patent & TMO/TM Mail Rcpt Dt. #58

MARK D. TANNEN,

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COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VA 22202-3514

Dear Sir:

TRANSMITTAL LETTER

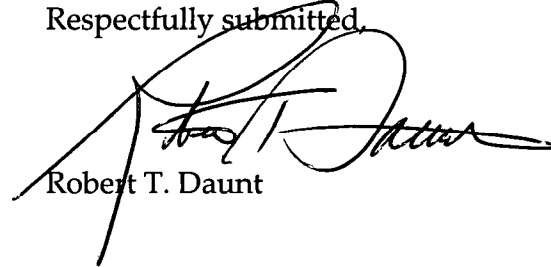
In connection with the above-identified opposition proceedings, transmitted herewith are the following:

- (1) Applicant's Objection to Opposer's Motion to Extend Time to Object and/or Respond to Discovery and to Extend Terms for Discovery and Testimony; Motion to Compel Response to Discovery Without Objections (10 pages), along with Exhibits 1 to 3; and

00/00/00 00:00:00
(2) Postcard.

Please date-stamp the enclosed postcard and return same to the undersigned in acknowledgment of receipt of all transmitted materials.

Respectfully submitted,



Robert T. Daunt

RTD:pte
August 20, 2003
DAVIS & SCHROEDER,
A Professional Corporation
P. O. Box 3080
Monterey, CA 93942-3080
Tel. No.: (831) 649-1122
FAX No.: (831) 649-0566
E-mail: rtd@NetLawyers.com